

Application No. 09/932,520
Docket No. 1999U021D1.US
Reply to Office Action Dated January 28, 2004

Remarks

Claim Amendments

Claims 1, 4-11, 13, 14, 35-37, 39 and 46 remain in this application. Claims 1, 7, 8, 11, 14 and 35 have been amended. Claim 46 is new. Periods have been added to the end of each of claims 11, 13 and 39. Claim 7 has been amended to incorporate a portion into claim 1, the remainder being amended to recite the metallocene. Claim 12 has been cancelled and incorporated into claim 11. Claims 2, 3, 15-34, 38 and 40-45 have all been previously cancelled. Claim 46 recites the acid /base combination that the Examiner suggests satisfies the first paragraph of 112. The amendment does not contain new matter and does not raise new issues requiring further search since the claims have been amended according to the Examiner's suggestions to remove that which he considers 112 deficiencies.

Section 112 Rejection

Withdrawal by the Examiner of the prior art rejection is noted with appreciation.

It is believed that all the claims previously presented in this application met the requirements of 35 U.S.C. 112, first paragraph. Nevertheless, in order to facilitate prosecution, a portion of claim 7 has been incorporated into claim 1, the remainder of the amendment to claim 7 relating to the metallocene. Claim 12 has been incorporated into claim 11. New claim 46 limits claim 35 to the acid base combination suggested by the Examiner.

In the Final Rejection the Examiner raised the issue of his "laboratory experience." Because the Examiner did not specify that which his laboratory experience entailed it is impossible for Applicant to properly respond to the "experience." It is therefore respectfully asked that should the Examiner maintain his position regarding the 112 rejection, the present Final Rejection be withdrawn and a new rejection be presented

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with either omission of remarks concerning laboratory experience or with a detailed affidavit explaining the laboratory experience that would support a 112 first paragraph rejection.

As stated in the Federal Register,

[o]ffice personnel should adhere to the following procedures when reviewing patent applications for compliance with the written description requirement of 35 U.S.C. 112 ¶ 1. The examiner has the initial burden . . . of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. There is a **strong presumption** that an adequate written description of the claimed invention is present in the specification as filed. (Fed. Reg. Vol. 66, No. 4 (Jan. 5 2001)). (emphasis added)

The present invention discloses a novel method of presenting the catalyst inhibitor/deactivator to the catalyst process. That method relates to a composition containing two ingredients that will react with each other at a temperature desirable for the deactivation of a polymerization process. It is therefore submitted to the Examiner that the ordinary practitioner in the art would not have to engage in experimentation in order to discover the proper combination of acid, base and catalyst to arrive at a workable catalyst that above the necessary temperature would be deactivated. The ordinary practitioner, given the teachings of this application, would not have to undergo experimentation in order to arrive at the proper combination of ingredients since he would know those temperatures at which deactivation is required and would know the reactants that would react to provide the deactivator.

The Examiner states that the specification is only enabling for the acid being L-malic acid and the base being an alkali or alkaline earth carbonate. As is well established, an application does not need to provide each and every combination of ingredients in order to be enabling. That which is required is a teaching that would allow the ordinary practitioner to practice the invention without undue experimentation. It is submitted that the disclosure of L-malic acid and an alkali or alkaline earth carbonate

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reacting together to form a deactivator would teach the ordinary practitioner that other combinations would work successfully and that the ordinary practitioner would readily know those combination to employ since such would be expected from the practicing chemist. Chemical reactions and the parameters at which compounds react are not generally a mystery to the ordinary practitioner.

The Examiner states that the ordinary skilled practitioner would have to experiment with the variables of time of reaction, temperature, pressure, solvents, and likely others. As mentioned above in the olefin polymerization arts such parameters are well established and hence would not require undue experimentation. The practicing ordinary chemist would know or quickly establish temperatures at which a polymerization process would have to be deactivated. Knowing such information and given the application disclosure, the ordinary practitioner would understand those combinations of ingredients that would react at the proper temperatures to form the inhibitor/deactivator.

Furthermore, claims 17, 11 35 and 46 now satisfy the Examiners objections and allowance should be in order since these claims are directed toward the very specific combination of components for which the Examiner indicates is enabled by the specification.

In any event, in view of the remarks above and the amendment to the claims it is now respectfully submitted that the all claims unequivocally satisfy 35 U.S.C. 112, first paragraph. Withdrawal of the rejection is respectfully asked.

Section 112 Rejection- Second paragraph

In view of the amendments to the claims it is now maintained that all the claims satisfy the second paragraph of 112. Claim 1, 1. 2 has been amended in accordance with the Examiner suggestion. Periods have been added to each of claims 11, 12 and 39. A

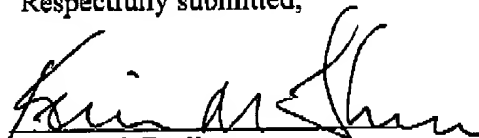
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space has been added after "11" in claim 12. Claim 35 has been amended in a manner similar to the manner in which claim 1, 1. 2 has been amended.

Withdrawal of the second paragraph 112 rejection is respectfully asked.

Respectfully submitted,

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